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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,787	05/14/2001	Akihisa Murata	Q64434	7102

7590 03/12/2003

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EXAMINER

ZIRKER, DANIEL R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 03/12/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO. <u>AS</u>
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 10

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.
Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

4. ☐ Applicant's reply has overcome the following rejection(s):

5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached Note.

7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 2-5

Claim(s) withdrawn from consideration: _____

9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.

10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

11. ☒ Other: Formal Drawings submitted 8/23/01 are acceptable

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300

1700

Daniel Zinker

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Note

1. The Examiner notes that applicants have traversed the prior art rejection of record set forth in paragraph No. 3 of Paper No. 8, which substantially reiterated the Examiner's earlier prior art rejection set forth in paragraph No. 3 of Paper No. 6. Specifically, applicants submit (Response, page 2) that XP-577 is non-enabling with respect to how to obtain the low antistatic values it claims to teach. However, the Examiner again reiterates his position originally set forth in paragraph No. 3 of Paper No. 6 on page 3 to the effect that "attaining such a performance parameter is both well known to one of ordinary skill in the art, and also notes that Gutman et al., U.S. 5,508,107, cited as evidence of the state of the art appears to teach that antistatic adhesive compositions and accompanying adhesive tapes in other related applications are well known in the art of transport of electrical current or prevention of electrostatic charge." It is noted that applicants' response has not even mentioned this essential element in applicants' position of record. Finally, it is again noted that accompanying the last Office action the Examiner was able to obtain machine translated copies of the entire text of Japanese Patent Abstract -910, which was earlier unavailable to the Examiner and ofⁿ which the disclosure of XP-577 is based. In reviewing this document, it appears to the Examiner that this

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reference appears to be enabling with respect to the antistatic performance parameter and it is also noted that applicants have not mentioned this reference in their latest response.

Accordingly, the Examiner must again rely upon his position of record and hold the claims to be finally rejected.

Dzirker:cdc

(703) 308-0031

March 10, 2003

Set Name Query

side by side

Hit Count Set Name

result set

DB=USPT,PGPB; PLUR=YES; OP=ADJ

<u>L1</u>	(pressure sensitive adhesive) or (self adhesive)	26856	<u>L1</u>
<u>L2</u>	((antistatic) or (anti static) or (anti?static))	30750	<u>L2</u>
<u>L3</u>	L1 and L2	1083	<u>L3</u>
<u>L4</u>	L1 same L2	82	<u>L4</u>
<u>L5</u>	L3 and ((428/922)!.CCLS.)	12	<u>L5</u>
<u>L6</u>	L3 and ((428/922)!.CCLS.)	12	<u>L6</u>
<u>L7</u>	L3 and ((428/40.1 or 428/343 or 428/346 or 428/354 or 428/355r or 428/355ac or 428/355en or 428/356).ccls.)	122	<u>L7</u>
<u>L8</u>	L4 and ((428/40.1 or 428/343 or 428/346 or 428/354 or 428/355r or 428/355ac or 428/355en or 428/356).ccls.)	25	<u>L8</u>

END OF SEARCH HISTORY